REMARKS

Claims 1-5 and 8, 9 and 11-17 are pending in this application.

Claims 1, 3, 4, 8, 11, 12 and 15 have been amended. Claims 7 and 10 have been canceled by this amendment without disclaiming its subject matter.

I. Claim Rejections - 35 U.S.C. §102

Claims 1, 2, 4, 5, 9, 12-14, 16 and 17 stand rejected under 35 U.S.C. §102 as being anticipated by Ryman (U.S. Pat. No. 6,721,155).

Claims 1 and 4 have been amended to incorporate the feature of claims 7 and 10, respectively.

Since the features of claims 7 and 10 are not disclosed in Ryman '155, claims 1 and 4, and their dependent claims 2, 5, 9, 12-14, 16 and 17 are not anticipated by Ryman '155.

II. Claim Rejections - 35 U.S.C. §103

Claims 3, 8 and 11 stand rejected under 35 U.S.C. §103 as being unpatentable over Ryman (U.S. Pat. No. 6,721,155) in view of Jones et al. (U.S. Pat. No. 6,061,223).

Claim 15 stands rejected under 35 U.S.C. §103 as being unpatentable over Ryman (U.S. Pat. No. 6,721,155) in view of Jones et al. (U.S. Pat. No. 6,061,223) and further in view of Sato et al..

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP section 2143 - Section 2143.03 for decisions pertinent to each of these criteria.

The examiner failed to establish a prima facie case of obviousness because the examiner failed to show that there is some suggestion or motivation to modify the reference.

First, the prior art does not suggests the desirability of the combination.

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)." (MPEP 2143.01)

Here, the examiner merely argued that, since Jones et al. (Col. 3, lines 41-45) disclose any coupling combinations which produce a capacitive effect, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Ryman with the capacitance device, as taught by Jones et al, to simplify the blocking capacitive mechanism.

The examiner should determine whether the prior art also suggests the desirability of the combination.

The references do not suggest the desirability. The examiner merely argued that the

combination would simplify the blocking capacitive mechanism. The examiner did not provide why the combination is to simply the blocking capacitive mechanism. There is no suggestion or teaching that the use of the capacitive device of Jones '223 is more desirable to simplify the blocking mechanism.

Since the prior art does not suggest the desirability of the combination or the modification, the examiner failed to show a prima facie case of obviousness.

Second, the prior art reference (or references when combined) did not teach or suggest all the claim limitations.

In claims 1, 3 and 4, for instance, the feature of the center conductor comprising a first conductor having a reception tube and a second conductor including a conductor shaft with an outer surface shape corresponding to a inner surface shape of the reception tube, the conductor shaft being inserted in the reception tube to function as electrode plates of a capacitor is recited

With the features recited in claims 1, 3 and 4, the present invention enables the first conductor and the second conductor to be disposed in close contact with each other, (by means of the anodized outer surface of the conductor shaft) *without inserting a separate element* or soldering. That is, the present invention can increase the capacitance of the capacitor nearly without limitation by constructing the capacitor with the first and second conductors assembled together.

The cited features are not disclosed in the prior art references in combination or individually.

Merely disclosing that "the surge blocking device 150 can be parallel rods, coupling devices, conductive plates, or any other device or combination of elements which produce a capacitive effect"

does not satisfy the third requirement for a prima facie case of obviousness (i.e., the prior art reference (or references when combined) must teach or suggest all the claim limitations). If we follow the examiner's reasoning, no capacitance device can be patentable because Jones '223 discloses "any coupling combinations."

Furthermore, the prior art reference does not recognize the problems, as stated above, which are solved by the present application, and does not provide a solution to achieve the above objectives.

Therefore, claims 1, 3 and 4 are patentable, and their dependent claims 2, 5, 9, 12-14, 16 and 17 are also patentable.

In view of the above, all claims are submitted to be allowable and this application is believed to be in condition to be passed to issue. Reconsideration of the rejections is requested. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

No fees are incurred by this Amendment. Should the other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

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